

Patent:
Attorney Docket: AUS920010310US1
(IBM/0011)

REMARKS

Applicant thanks the Examiner for taking the time to discuss the pending office action with Applicant in a telephone interview. The issues discussed in the telephone interview are included in the following remarks.

Claims 31, 36 and 48-52 stand objected to for certain informalities. Applicant has amended the claims to correct the informalities. Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claims 1, 3-4, 12, 17, 20-23, 25-26 and 34 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,526,575 issued to McCoy, *et al.* Applicant claims a method, system and computer program product for making syndicated content available on-line comprising, *inter alia*, maintaining an electronic database of previously registered content items that are available for distribution to or purchase by an online content purchaser and of distribution parameters associated with each of the previously registered content items, *wherein a plurality of the registered content items are simultaneously distributed when selected by a plurality of content purchasers*; receiving a request to register an additional content item; *determining whether the additional content item can be registered for distribution by determining if there is a conflict*; and registering the additional content item if there is no conflict. (Claims 1, 17, 23).

McCoy discloses a *scheduling* method for scheduling programming to be shown by a cable operator. A method for scheduling does not claim each and every limitation claimed by Applicant in Applicant's method that includes registering. McCoy discloses a method for the creation process of an exemplary schedule comprising four different "skeletons." (McCoy, col. 16, line 53 – col. 17, line 22). Each skeleton is ranked such that, for example, the first skeleton includes advertisements that must be broadcast (national advertisers) and the fourth skeleton is filler segments, which fill the gaps in the schedule. *Id.* As such, McCoy discloses a method for determining *when* an advertisement may be broadcast on the schedule.

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MPEP § 2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

Applicant claims a method that does not determine when a content item will be distributed but whether a content item will be distributed. Applicant has amended claims 1, 17, and 23 to include the limitation that the plurality of registered content items are capable of simultaneous distribution when selected by a plurality of content purchasers. Applicant claims a method, system and computer program product that provides for simultaneous distribution of multiple content items, which McCoy does not contemplate. McCoy schedules items for broadcast so that the items do not overlay – McCoy has a timeslot to fill with one and only one content – an advertisement. Once the timeslot is filled with an advertisement, another advertisement cannot fill that timeslot unless the first advertisement is moved to another timeslot. Therefore, McCoy is able to broadcast only one advertisement at a time and therefore, is a *scheduling* method.

In the invention claimed by Applicant, a determination is made *whether* a content item can be registered for distribution, not *when* a content item can be registered for distribution. In the invention claimed by Applicant, there is no limit imposed that only one item – such as the advertisement scheduling method of McCoy – can be distributed at one time. An example provided in the specification provides that *if* a baseball game is being distributed in a particular time slot having a distribution parameter *providing that no other sporting event may be distributed* at the same time, then a soccer game would be refused registration. (Specification, p. 9, lines 9-14) Likewise, *if* a live theater performance was being distributed in a particular time slot having a distribution parameter *providing that no other live theatrical performance could be distributed* at the same time, then a different theatrical performance would be refused

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registration. *Id.* However, *without* the exclusivity conflict, then the baseball game and soccer game or the two theatrical performances *could be distributed at the same time*. The current invention seeks to enforce exclusivity parameters when demanded by the content providers. The present invention, unlike the cited prior art, does not seek to fill a broadcast schedule.

As the specification discloses, the registered content contained in the database is available for distribution to the online purchasers subject to the exclusivity constraints. (Specification, p. 13, lines 15-24). Therefore, an online purchaser may connect to the system and view, for example, newspaper subscriptions, newsletters and video feeds, none of which would require a scheduling step as would be required by McCoy. (Specification, p. 8, lines 13-17).

The cited prior art does not disclose that a plurality of registered content items is capable of simultaneous distribution when selected by a plurality of content providers. Furthermore, the cited prior art does not determine *whether* an additional content item can be registered for distribution to enforce exclusivity agreements of previously registered content. Therefore, because the cited prior art does not disclose each and every limitation claimed by Applicant in as complete detail as claimed in the Applicant's claims, Applicant respectfully asserts that a *prima facie* case of anticipation has not been presented. Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1, 17 and 23 as well as all claims that depend therefrom.

Claims 10-11, 13-16, 32-33, 35-43 and 47-51 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,526,575 issued to McCoy, *et al.*, in view of U.S. Patent No. 5,835,843 issued to Haddad. Applicant has amended independent claims 39 and 49 to include the limitations that a plurality of the registered content items are capable of simultaneous distribution when selected by a plurality of content purchasers and comparing the requested distribution parameters with business parameters that define site policy for determining whether the additional content item can be registered for distribution.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985

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(CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

For the reasons provided in the remarks above, Applicant respectfully asserts that neither McCoy nor Haddad disclose, suggest or teach either of the claimed limitations added by amendment to claims 39 and 47. In fact, Haddad, like McCoy, provides a scheduling method that determines *when*, not *whether*, a particular item can be distributed or broadcast.

Therefore, because Haddad and McCoy do not disclose, teach or suggest each and every limitation claimed by Applicant, Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented. Therefore, reconsideration and withdrawal of the rejection of independent claims 39 and 47 is respectfully requested, as well as all dependent claims that depend therefrom and for all dependent claims that depend from independent claims 1, 17 and 23.


Claims 2, 5-8, 24 and 27-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,526,575 issued to McCoy, *et al.* in view of U.S. Patent No. 5, 311,423 issued to Clark. Claims 18-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,526,575 issued to McCoy, *et al.* in view of U.S. Patent No. 6,151,631 issued to Ansell, *et al.* Claims 9 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,526,575 issued to McCoy, *et al.* in view of U.S. Patent No. 5, 311,423 issued to Clark, in further view of U.S. Patent No. 6,151,631 issued to Ansell, *et al.* Claims 10-11, 13-16, 32-33, 35-43 and 47-51 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy *et al.*, U.S. Patent 6,526,575 in view of Haddad, U.S. Patent 5,835,843. Claims 44-46 and 52-54 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,526,575 issued to McCoy, *et al.* in view of U.S. Patent No. 5,835,843 issued to Haddad, and in further view of U.S. Patent No. 5,311,423 issued to Clark. Each of these rejections are for claims that depend, either directly or indirectly, on independent claims 1, 17, 23, 39 or 49. For the reasons discussed in the remarks above, Applicant respectfully requests reconsideration and withdrawal of these rejections as being rejections of dependent claims that depend from the independent claims 1, 17, 23, 39 or

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49.

Applicant respectfully asserts that all claims are now in condition for allowance and request a timely issuance of a Notice of Allowance. If the Examiner believes that the examination of this application may be expedited by a telephone interview, the Examiner is invited to telephone the below signed attorney at the Examiner's convenience. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/IBM/0011 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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